

Appn. No. 09/981,483
Arndt dated May 7, 2004
Reply to Office action dated Jan. 16, 2004

PATENT
Customer No. 22,878
Attorney Docket No. 10003016-1
Finnegan Ref. No.: 07896.0058-00000

REMARKS / ARGUMENTS

In response to the Advisory action dated April 7, 2004, Applicants respectfully request the Office to enter the following amendments and consider the following remarks. It is believed that all objections to the previous amendment after final have been addressed. By this response, claims 6, 7, 11, 21, and 23 have been amended, and claims 1-5, 8-10, 12-20, 22 and 32-41 have been canceled without prejudice. With respect to the pending claims, claims 6-7, 11, 21, 23-31 and 42-43 remain pending in this application, and new claims 44-71 have been added. Authorization is hereby given to charge any fees (e.g., extension fees) associated with this response to Deposit Account No. 50-1078.

In the original, final Office action dated January 16, 2004 ("OA"), the Examiner objected to Fig. 2 because a reference sign was not referenced in the written description, rejected claims 1-5, 8-10, 12-20, 22-26, 29 and 32-39 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,772,586 to Heinonen et al. ("Heinonen"), rejected claims 27 and 28 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Heinonen, and rejected claims 30, 31, 40 and 41 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Heinonen further in view of U.S. Published Patent Application No. 2003/0083685A1 to Freeman et al. ("Freeman"). Claims 21, 42 and 43 were indicated as being allowable, as were claims 6, 7, and 11, if rewritten in independent form.

Applicants submit that the proposed amendments of claims 6, 7, 11, 21, and 23 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Moreover, these are the claims that the Examiner has not

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indicated as being problematic in his Advisory action (indeed, all of the claims identified as such have been canceled). Applicants respectfully argue for allowance as follows.

Drawings

The Examiner has objected to Figure 2 under 37 C.F.R. § 1.84(p)(5) on the basis that it includes reference sign "200," which is not mentioned in the description. See OA at page 2, ¶1.

Applicants have amended paragraph [027] of the written description (which begins at page 8, line 18) to recite that reference sign 200 in Fig. 2 refers to a cut-away view of a portable medical analyzer as stated earlier in the brief description of the drawings. See paragraph [012].

Applicants submit that no new matter has been added via this amendment.

Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-5, 8-10, 12-20, 22-26, 29 and 32-39 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Heinonen. See OA, page 2 ¶ 3.

As an initial matter, Applicants have canceled claims 1-5, 8-10, 12-20, 22 and 32-39, without prejudice, and submit that the instant rejection with respect to these claims has been rendered moot. Claim 23 has been amended to include language¹ that recites the subject matter indicated as not being taught or suggested by Heinonen (see Response dated March 19, 2004, which is hereby incorporated by reference), and further confirmed as not raising any new issues in the Advisory action (see pages 2 and 3 thereof). Thus Applicants respectfully submit that claim 23 and all of its dependent claims are allowable for at least the reasons set forth herein (including the Response dated March 19, 2004, which is incorporated), and accordingly, that the rejection of these claims under 35 U.S.C. § 102 be withdrawn.

¹ such language being necessarily present in the dependent claims, as well (claims 24-26 and 29).

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Claim Rejections - 35 U.S.C. § 103(a)

Claims 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heinonen. See OA, page 4, ¶ 5. Relatedly, claims 30, 31, 40 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Heinonen as applied to claims 23 and 32 above, and further in view of Freeman.

Claims 40 and 41 have been canceled without prejudice, and thus it is submitted that the instant rejection to these claims under 35 U.S.C. § 103 has been rendered moot.

As set forth in the listing of claims and the discussion immediately above, Applicants have amended claim 23 (the independent claims from which all of the other claims rejected under §103 depend, namely claims 27-28, 30 and 31) to include claim elements that define over Heinonen, the primary references used in these rejections. Applicants respectfully submit that Heinonen, alone or in combination with either the knowledge of a skilled artisan or Freeman, does not teach or suggest the subject matter now recited in all of the claims subject to the instant rejection. Therefore, because their base claims, as amended, recite features that impart patentability over the cited references, Applicants respectfully submit that the rejections to claims 27, 28, 30, and 31 under 35 U.S.C. § 103 have been overcome.

Subject Matter Indicated to be Allowable

The Office has indicated that claims 21, 42 and 43 have been allowed, and that claims 6, 7 and 11 would be allowable if rewritten in independent form.

Applicants have rewritten claims 6, 7 and 11 as suggested, and respectfully requests allowance of these claim.

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Allowed claim 21 has been amended regarding antecedent basis; these simple changes, mere typographical corrections made to an *allowed* claim, are obviously made for reasons unrelated to patentability.

New Claims

All of the new claims depend directly or through intermediary claims from claim 21, which was indicated by the Examiner to be allowable. These new claims are dependent claims that track dependent claims already of record in this application - specifically, they track (generally in order) the dependent claims that were previously presented and/or canceled. Therefore, Applicants submit both that new claims 44-71 do not present new matter, and that they are also allowable for at least the same reasons.

Applicants respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 6-7, 11, 21, 23-31 and 42-71 in condition for allowance. Again, Applicants submit that the proposed amendments of claims 6, 7, 11, 21, and 23 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

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Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims. Furthermore, especially given the application's status in final, the Examiner is urged to contact Andrew B. Schwaab at 650-849-6643² if there are any additions/changes Applicants can make to facilitate or expedite allowance of the application.

Please grant any extensions of time required to enter this response and charge any additional required fees to deposit account 50-1078.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 7, 2004

By: 
Andrew B. Schwaab
Reg. No. 38,611

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax Number (703) 872-9306 on May 7, 2004.

Signature: 

Andrew B. Schwaab

² and/or via facsimile as well, at 650-849-6666 (e.g., for advisory actions, etc.).